

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Achs et al. Confirmation No. 3993
Appl. No.: 09/786,027 Filed: May 15, 2001
Patent No.: 6,550,232 Issued: April 22, 2003
For: ENERGY GUIDE CHAIN FOR GUIDING LINES
COMPRISING CHAIN LINKS WHICH CAN MOVE IN
THREE DIMENSIONS

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450
ATTN: Licensing and Review

DECLARATION OF DITMAR NEUMANN

I, Ditmar Neumann, declare the following:

1. I am a citizen of Germany, residing at Erkelenz, Germany.
2. I am a licensed Patentanwalt in Germany, and also a licensed European Patent and Trademark Attorney. Beginning about 1994, I was a member of the firm Bardehele Pagenberg Dost Altenburg Geissler (BDL), which is located in Düsseldorf and Munich, Germany.
3. Beginning about 1992, BDL has represented Kabelschlepp GmbH, a German corporation located in Siegen, Germany, in connection with its patent and other intellectual property matters. Since about 1994, I was the patent attorney within BDL, who was responsible for the work performed by BDL for Kabelschlepp GmbH.
4. In March of 1998, Kabelschlepp authorized BDL to file a patent application in Germany relating to an energy chain which was suitable for a sliding door system of a van, which had been developed by employees of the company. German patent application No. 198 39 575.2 was accordingly filed in Germany on August 31, 1998. The application was filed without designating the inventors, which is permissible under German law, and at that time our office was unaware of the names and nationalities of the inventors.

5. A few days before the end of the one year priority period, BDL receive a fax from Ms. Ossenbergh of Kabelschlepp GmbH asking BDL to file a corresponding international application under the PCT, and listing the names and nationalities of the three inventors, which is required for the PCT filing. There was nothing in the fax, or in any other information that was provided to BDL by Kabelschlepp, that caused a question to be raised whether any part of the invention may have been made in the U.S. BDL therefore proceeded to file the following application, in the normal manner.

- PCT International Application No. PCT/EP99/06373 filed on August 13, 1999 in the European Patent Office.

6. During 2000, I and several other patent attorneys formed the firm Kahlhöfer Neumann Heilein (KNH) in Düsseldorf, Germany, which continued to represent Kabelschlepp. The office of KNH proceeded to file the following applications:

- Japanese National Phase Patent Application No. 2000-567863 filed February 20, 2001.
- European National Phase Patent Application (designating Germany, France, and Italy) No. EP 9906373 filed February 28, 2001.
- U.S. National Phase Application 09/786,027, filed February 28, 2001.

6. After filing the U.S. national phase applications, KNH received a letter dated March 15, 2001 from our U.S. associates which for the first time raised the question whether the invention was made in the U.S. and whether we needed to file a Petition for a retroactive foreign filing license under the provisions of 35 USC §184. This was the first time anyone in our office became aware of the possible

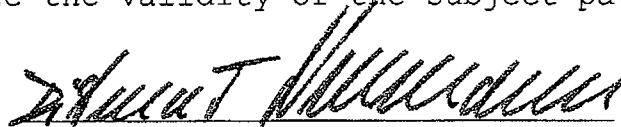
requirement for a foreign filing license under U.S. law with regard to the above referenced patent applications.

7. Subsequent to March 15, 2001, I corresponded with our U.S. associates, and our U.S. associates corresponded directly with Stephan Achs who was one of the named inventors, to determine the facts surrounding the conception and development of the invention. Based upon this correspondence, it was decided that we should file a Petition for a retroactive foreign filing license under 37 CFR 5.25, and the Petition was filed on June 11, 2001.

8. The invention as disclosed in the above referenced patent applications was not under a secrecy order at the time of their filings, and it is not currently under a secrecy order.

9. It is my belief that the above referenced patent application filings which occurred without first obtaining a foreign filing license from the U.S. authorities, occurred through error and without deceptive intent, and I believe that the U.S. attorneys and KNH made a diligent effort to ascertain the circumstances surrounding the invention and apply for a license as required by U.S. law and regulations.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the subject patent.


Ditmar Neumann

Date: _____

6. Nov. 2006